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10/676,807	10/01/2003	Stephen Alan Smith	503177.00387	3085

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EXAMINER

CASTELLANO, STEPHEN J

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3781

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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Group 3700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/676,807
Filing Date: October 01, 2003
Appellant(s): SMITH ET AL.

Gregory G. Schlenz
For Appellant

EXAMINER'S ANSWER

Art Unit: 3781

This is in response to the appeal brief filed July 5, 2007 appealing from the Office action mailed December 4, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Serial No. 11/101,932 has a Notice of Appeal filed therein.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

- (1) the D499935 Smith patent is duplicated or stated twice, and
- (2) the D508822 Smith patent has been deleted because it doesn't disclose an annular shoulder and arched portion.

Examiner's Restatement of Ground of Rejection:

Claims 1 and 4-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims (the drawings) of U.S. Design Patent No. D514385, D514380, D505830, D504593, D499935, D499934, D514884 all of these design patents to Smith et al. (Smith), individually, in view of Hawley (3519165).

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 1 and 4-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-12, 14, 15 and 21-34 of copending Application No. 11/101932 to Smith et al. (Smith) in view of Hawley (3519165).

Claims 1 and 4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards (D196271) in view of Hawley (3519165). The examiner's comment made in the

Art Unit: 3781

interview of January 16, 2007 about withdrawing the Edwards-Hawley rejection was made in error.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

D514884	SMITH et al.	2-2006
D514385	SMITH et al.	2-2006
D514380	SMITH et al.	2-2006
D505830	SMITH et al.	6-2005
D504593	SMITH et al.	5-2005
D499935	SMITH et al.	12-2004
D499934	SMITH et al.	12-2004
3519165	HAWLEY	7-1970

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 4-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims (the drawings) of U.S. Design Patent No. D514385, D514380, D505830, D504593, D499935, D499934, D514884 all of these design patents to Smith et al. (Smith), individually, in view of Hawley.

Each of these seven Smith design patents individually discloses the invention except for the stacking of a second cup inside of a first cup. Five of these patents are extremely similar to each other in what they disclose and are particularly similar to appellant's presently disclosed embodiment represented by Fig. 1-9. These fabulous five references are D514380, D505830, D504593, D499935 and D499934. The disclosure among these five references differs by what is disclosed by phantom line and what is disclosed and emphasized by solid lines with shading. The recess, annular shoulder, arched portion of the annular shoulder, inner stacking surface formed by the annular shoulder and raised ledge formed by the arched portion are all shown in exactly the same location as these elements are shown in Fig. 1-9 of appellant's application. There may be only slight variations in the shape and size of certain elements but all five references are remarkably similar to appellant's disclosure.

The disclosure of D514385 differs more only in that the arched portion of the annular shoulder is shown rotated approximately 90 degrees from the recess rather than aligned with the recess as is shown with the fabulous five references.

The disclosure of D514884 differs in that the presence of the arched portion and raised ledge formed by the arched portion is almost not perceptible but is definitely present when Fig. 10 is closely examined and compared to similar views of the fabulous five references.

Hawley teaches the nesting. It would have been obvious to modify the single cup to have at least one other or multiple cups in a nested configuration to provide compact storage and transport for efficient packaging, storage and transport of cups. Upon nesting of the cups of these design references, the structure is such that the raised ledge of a first cup sits within the arched portion of a second identical cup nested thereabove because the dimensional relationships

Art Unit: 3781

and elements are configured exactly the same or so similar to that disclosed by appellant's application.

It would have been obvious to remove the claimed structure in the drawings of the design references of Smith which is not claimed in the present invention (appellant's present claims) from the design references of Smith as such structure is not necessary.

(10) Response to Argument

Appellant argues two points, (1) applying one-way obviousness or one-way distinction in an obviousness double patenting rejection (ODP) that is a design-utility situation (i.e., design patent used to reject a utility claim) is improper and (2) that two-way obviousness can't be established in this case. For this case, the proper criteria is one-way obviousness. The rejection sets forth proper analysis for one-way obviousness by showing that appellant's claims are obvious and unpatentable over the Smith design patents in view of Hawley.

It is noted that appellant's discussion of two-way obviousness has no discussion of the obviousness of appellant's claims. In other words, appellant only discusses the second part of two-way obviousness by discussing that the Smith design patents' claims (drawings) are not obvious in view of appellant's written claims. This type of argument is moot because only one-way obviousness is the proper criteria.

Two-way obviousness maybe the proper criteria in certain case specific situations. *In re Dembiczak* and *Carman Indus., Inc v. Wahl* are two case specific situations which required two-way obviousness. However, the fact situation in these court cases differs from the facts of the present case.

Art Unit: 3781

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Evidence Appendix

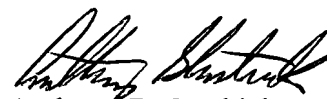
Appellant has not submitted any items in the evidence appendix.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stephen J. Castellano/
Stephen J. Castellano
Primary Examiner

Conferees:


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